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EXAMINER

NGUYEN, DUSTIN

ART UNIT	PAPER NUMBER
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2154

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11/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/605,874	Applicant(s) RAGNET ET AL.	
	Examiner Dustin Nguyen	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>04/29/2004, 09/21/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-20 are presented for examination.

Response to Election/Restrictions

2. Applicant's election with traverse of invention I, claims 1-16, in the reply filed on 08/27/2007 is acknowledged. The traversal is on the ground(s) that all of claims 1-20 sufficiently related that a thorough search for the subject matter of any one Group of claims would encompass a search for the subject matter of the remaining claims. This is not found persuasive because there are two criteria for a proper requirement for restriction between patentably distinct invention: the invention must be independent or distinct as claimed, and there would be a serious burden on the examiner if restriction is not required. In this case, Group I, claims 1-16, are drawn to a system and method for submitting a document service request from a mobile device to a document processing device, classified in class 709, subclass 219, whereas Group II, claims 17-20, are drawn to a system and method for a first document processing device to redirect a document service request submitted by a mobile device to a second processing device, classified in class 709, subclass 225. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

The requirement is still deemed proper and is therefore made FINAL.

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3. Claims 17-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Group II, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in the reply filed on 08/27/2007.

Specification

4. Examiner requests Applicants to update status of related cases as mentioned in the disclosure, paragraphs 0016, 0019, 0038, 0060, and 0086.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The claim language in the following claims is being considered as indefinite:

I. As per claim 1, the claimed limitation of “submitting, from the mobile device over the first connection with the document processing device, the document service request together with a device identifier to an output server coupled to the second network, receiving, at the mobile device over the first connection with the document processing device, the document in

a second format from the output server, the second format of the document being an input format of the document processing device” is not clearly explained the connections between the mobile device, document processing device, output server and the first and second networks.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 14-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Berkema et al. [US Patent Application No 2005/0030375].

9. As per claim 14, Berkema discloses the invention as claimed including a method for controlling a plurality of document service request at a mobile device to be carried out at a document processing device [i.e. methods for printing documents from portable devices] [Figures 1 and 2; and paragraphs 0001 and 0008], comprising:

defining in a job ticket for an identified document at the mobile device a workflow that specifies two or more document service requests for which at least one of the plurality of

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document service requests is to be performed at the document processing device [i.e. XML tag for print by reference print job] [paragraphs 0022 and 0025]; and

transmitting the job ticket from the mobile device to the document processing device upon receipt of input instructing the document service request to be carried out at the document processing device [i.e. print by reference print job should be initiated] [paragraphs 0027, 0041 and 0049];

wherein the document processing device is adapted (a) to perform all document service requests specified in the job ticket or (b) to forward processed document result data and the job ticket to another document processing device to perform uncompleted ones of the document service request specified in the job ticket [i.e. report print job status] [paragraphs 0035 and 0046].

10. As per claim 15, Berkema discloses wherein the workflow includes multiple paths [Figures 1 and 2; and paragraphs 0026-0029 and 0038].

11. As per claim 16, Berkema discloses wherein the plurality of document service requests include a scan service request [paragraph 0057] and at least another document service request comprising once of summarizing, OCRing, storing, and sharing [paragraphs 0028 and 0046].

12. Claims 10-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamamoto et al. [US Patent Application No 2003/0217103].

13. As per claim 10, Yamamoto discloses the invention as claimed including a method for submitting a document service request from a mobile device to a document processing device coupled to a first network and being adapted to communicate with one or more servers coupled to a second network [Figure 1; and paragraphs 0029-0036], comprising:

establishing, from the mobile device, a first connection and a second connection with the document processing device [i.e. send select execution of scanning and destination data and job No.] [P63, Figure 4; P81, Figure 5; and paragraphs 0137, 0143, 0145 and 0157];

specifying, at the mobile device, a document scan request that identifies a document service to be applied to a hardcopy document input to the document processing device [PR1, Figure 2; and paragraphs 0009, 0040 and 0106];

submitting, from the mobile device over the first connection, the document scan request [P60-P62, Figure 4; Figure 8A; and paragraphs 135-137];

receiving, at the mobile device over the first connection, a scanned document from the document processing device [P74, Figure 5; and paragraphs 0149 and 0163]; and

resending to a file server coupled to the second network, at the mobile device over the second connection, the scanned document received from the document processing device together with a location for storing the scanned document on the file server [P44, Figure 3; and paragraphs 0115 and 0158].

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14. As per claim 11, Yamamoto discloses wherein the document service request is a job ticket that specifies a workflow defining a combination of two or more document services [paragraphs 0069, 0106, 0107, 0110 and 0147-0149].

15. As per claim 12, Yamamoto discloses wherein the document processing device is adapted (a) to perform all document service requests specified in the job ticket or (b) to forward processed document result data and the job ticket to another document processing device to perform uncompleted ones of the document service request specified in the job ticket [P48, Figure 3; and paragraph 0123].

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 1-9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berkema et al. [US Patent Application No 2003/0002072], in view of Yamamoto et al. [US Patent Application No 2003/0217103].

18. As per claim 1, Berkema discloses the invention as claimed including a method for submitting a document service request from a mobile device to a document processing device

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coupled to a first network and being adapted to communicate with one or more servers coupled to a second network [i.e. method for printing documents from portable device] [Figures 1-4; and paragraphs 0001, 0008-0013], comprising:

specifying, at the mobile device, a document service request that includes a document identifier identifying a document in a first document format and its location on the second network [i.e. print reference] [Abstract; and paragraphs 0022 and 0025];

submitting, from the mobile device over the first connection with the document processing device, the document service request together with a device identifier to an output server coupled to the second network [Figure 1; and paragraphs 0018, 0022, 0027-0029];

receiving, at the mobile device over the first connection with the document processing device, the document in a second format from the output server [Figure 2; and paragraphs 0038, 0045 and 0046];

the second format of the document being an input format of the document processing device [paragraphs 0052 and 0055]; and

resending, from the mobile device over the second connection with the document processing device, the document received from the output server in the second format to the document processing device for performing a specified document service thereon [paragraphs 0037, 0045, 0052 and 0055].

Berkema does not specifically disclose

establishing, from the mobile device, a first connection and a second connection with the document processing device.

Yamamoto discloses

establishing, from the mobile device, a first connection and a second connection with the document processing device [i.e. send select execution of scanning and destination data and job No.] [P63, Figure 4; P81, Figure 5; and paragraphs 0137, 0143, 0145 and 0157].

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Berkema and Yamamoto because the teaching of Yamamoto would provide multiple interface to increase the capability of the device and enhance services.

19. As per claim 2, Berkema discloses browsing, from the mobile device over the first connection with the document processing device, a file server coupled to the second network; said browsing providing the document identifier of the document having the first document format [i.e. select content] [paragraphs 0023 and 0055].

20. As per claim 3, Yamamoto discloses wherein the first connection and the second connection between the mobile device and the document processing device are wireless connections [i.e. Bluetooth] [paragraphs 0077 and 0078].

21. As per claim 4, Berkema discloses wherein the document service request is a job ticket that specifies a workflow defining a combination of two or more document services [i.e. XML tag for print by reference print job] [paragraphs 0022 and 0025].

22. As per claim 5, Berkema discloses wherein the document processing device is adapted (a) to perform all document service requests specified in the job ticket or (b) to forward processed

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document result data and the job ticket to another document processing device to perform uncompleted ones of the document service request specified in the job ticket [i.e. report print job status] [paragraphs 0035 and 0046].

23. As per claim 6, Berkema discloses wherein the output server retrieves the document in the first format from the file server using the document identifier and converts the document into the second format using the device identifier [i.e. convert into printer format] [paragraphs 0002-0004; 0009 and 0045].

24. As per claim 7, Berkema discloses wherein the first document format is different from the document in the second format [paragraphs 0032-0034 and 0043].

25. As per claim 8, Berkema discloses wherein the device identifier identifies input formats that may be processed by the document processing device [paragraph 0025].

26. As per claim 9, Berkema discloses wherein said resending resends the document received from the output server together with properties of the document service request [Figures 2 and 4; and paragraphs 0045 and 0055].

27. As per claim 13, it is rejected for similar reasons as stated above in claim 1.

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28. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (571) 272-3971. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached at (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dustin Nguyen

Examiner

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